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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,246	01/18/2001	Jonathan Lowthert	INTL-0510-US (P10479)	8160
21906	7590	'12/14/2005	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			RAMAN, USHA	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/765,246

Applicant(s)

LOWTHERT ET AL.

Examiner

Usha Raman

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-5-05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 11 and 21 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (U.S. Patent No. 6,029,045) in view of Moshfeghi et al. (US Pat. 6,076,166).

Regarding Claim 1, Picco discloses a method comprising allowing the use of content (Col. 4, Lines 51-54) on a content receiver (See Figure 4 and Col. 5, Lines 10-16), collecting information about a characteristic of the receiver (Col. 6, Lines 34-37, Col. 10, Lines 58-62 and Col. 11, Lines 9-13) and providing that information to a remove processor-based system (Col. 7, Lines 6-26). The information is used to select, from an advertising database (Col. 6, Line 57 - Col. 7, Line 6), an advertising subset that is based on the characteristic of the receiver (Col. 7, Lines 28-32). The receiver receives the advertising subset and selectively chooses Ads from the subset for storage (Col. 7, Lines 35-61 and Col. 8, Lines 7-16) and automatically interrupts the use of content to temporarily replace the content with an advertisement (Col. 6, Lines 23-31 and Col. 8,

Lines 19-39)

Picco teaches the step of collecting characteristic about the user preferences at the receiver and is silent about collecting information about at least one of hardware and software present on the receiver.

Moshfeghi discloses a method of personalization of content (customization of web pages based on user's preferences as well as user's receiver characteristics) at user end by collecting information about the hardware and software (i.e. user's computer environment) on the receiver as part of user profile information. See Moshfeghi: column 1, lines 42-58.

It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the system of Picco by using the personalization techniques of Moshfeghi, in order to customize content based on user preferences as well as receiver hardware/software configurations. The motivation is to present information to the user based on capabilities of user's receiver characteristics.

Regarding Claim 2, Picco discloses a method as stated above in Claim 1, wherein the set top box is operable to update content (Col. 7, Lines 35-4!) by storing selected local content as stated above, including overwriting or removing selected content (Col. 10, Line 62- Col. 11, Line 1). This reads on the claimed combining the advertising subset with advertising available on the receiver.

Regarding Claim 3, Picco discloses a method as stated above in Claim 1, wherein collecting information includes monitoring the activities of the user of the receiver (Col. 11, Lines 9-13).

Regarding Claim 4, Picco discloses a method as stated above in Claim 3, wherein collecting information includes accumulating the collected data (Col. 11, Lines 9-13). This accumulation of user data reads on the claimed developing a database of information about activities undertaken by the user of the receiver.

Regarding Claim 5, Picco discloses a method as stated above in Claim 4, wherein advertisements are stored in a remote database and a subset of these ads are broadcast to user terminals for selective storage based on user profile information as stated above. This reads on the claimed selecting advertisements stored on the remote processor-based system (ads from the head-end's database) based on information about the user of the receiver (user profile).

Regarding Claim 6, Picco discloses a method as stated above in Claim 5, wherein advertisements available on the remote processor based system are broadcast to the terminals for storage as stated above. This reads on the claimed accessing of advertisements available on the remote processor-based system. It is inherent that the user's terminal must in some way catalog the data it has stored order to manage and retrieve the data (Col. 10, Lines 62-67). This reads on the claimed compiling a local electronic guide (catalog of files) to advertising resources by accessing (receiving and storing) advertisements available on the remote processor-based system (head-end database of advertisements).

Regarding Claim 7, Picco discloses a method as stated above in Claim 1, wherein the advertising has associated an associated content profile, which is compared to the user's profile for storage and playback (Col. 7, Line 55 - Col. 8, Line

22). This reads on the claimed determining a characteristic of advertising and comparing it to information about the use of the receiver.

Regarding Claim 8, Picco discloses a method as stated above in Claim 1, wherein a user is operable to select television signals from satellite broadcasting for watching (Col. 5, Lines 10-16). The watching of satellite television signal reads on the claimed enabling a variety of content to be selected for play at any time.

Regarding Claims 9 and 10, Picco discloses a method as stated above in Claim 1, wherein content has an expiration date (Co1. 6, Lines 61-67) and a maximum number of times it may be viewed (Co1. 7, Lines 1-2). Further, the terminal may remove or overwrite content (Co1. 10, Line 62 - Col. 11, Line 1). This reads on the claimed automatically replacing (overwriting) the content with advertising after allowing content to be used for a predetermined amount of time (date or number of views). This further reads on the claimed automatic determination at predetermined times whether to replace the content.

Regarding Claim 11, see Claim 1 above.

Regarding Claims 12-19, see Claims 8, 3-7 and 9-10 respectively.

Regarding Claim 20, Picco discloses an article as stated above in Claim 11, further storing instructions that enable to receiver to catalog the advertisements it has stored as stated above. This reads on the claimed automatically compiling a receiver- based database of advertising.

Regarding Claim 21, see Claim 1 above. It is inherent that such a computer-based terminal must nm programming in order to function. This reads on the claimed shell.

Regarding Claim 22, Picco discloses a method as stated above in Claim 21, wherein the system is a television receiver (Co1. 5, Lines 12-16).

Regarding Claims 23-28, see Claims 9-10, 8, 3-4 and 6 above, respectively.

Regarding Claim 30, see Claim 6 above.

Regarding Claim 31, see Claim 28 above.

Regarding Claim 32, see Claim 28 above. Further, it is implicit that such television-based advertising must be in one or more known languages. This reads on the claimed advertisements specialized for a particular language.

### ***Conclusion***


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600